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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,780	10/20/2000	Arturo A. Rodriguez	A-6694	8562

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SCIENTIFIC-ATLANTA, INC.  
INTELLECTUAL PROPERTY DEPARTMENT  
5030 SUGARLOAF PARKWAY  
LAWRENCEVILLE, GA 30044

EXAMINER

BELIVEAU, SCOTT E

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 09/25/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/693,780

Applicant(s)

RODRIGUEZ ET AL.

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Priority***

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application (60/214,978) upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1, 11, 18, 25, 32, 44, and 51 of this application. In particular, the examiner is unclear as to where support can be found pertaining to offering the user the ability to select whether or not comments consisting of director comments, producer comments, actor comments, and viewer comments may be described within the provisional application.
2. With respect to applicant's claim for priority as a continuation-in-part to co-pending application No. 09/590,520, the earlier application discloses the overall system architecture of the utilized by the instant application (Figures 1-2) and illustrates similar GUI screen-shots. The claimed subject matter of the independent claims of the instant application pertains to the user requesting "on-screen comments" to be provided. As the examiner is unclear as to where this subject matter may be found in the parent application, the claims of the instant application shall be examined in view of the filing date of the instant application (19 October 2000).

### ***Response to Amendment***

3. The amendment filed 29 May 2001 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The preliminary amendment filled

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more than 3 months subsequent to the filing of the instant application added material which is not supported by the original disclosure. Newly added claims 43 and 55 state that media presentations may be free subsequent to an agreement by the user to watch advertising.

While the disclosure as originally filed suggests that discounts may be applied, there is no suggestion that the discount necessarily creates the claimed scenario. Applicant is required to cancel the new matter in the reply to this Office Action.

### *Drawings*

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: “43” (Page 4, Line 32) and “113” (Page 12, Line 9). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 74 (Figure 3); 88, 89, 90 (Figure 4); 107, 108 (Figure 5); 121 (Figure 7); 121 (Figure 10). A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
6. The drawings are objected to because examiner believes that element “121” in Figure 10 should be referencing element “131” in order to be consistent with previous figures. A proposed drawing correction or corrected drawings are required in reply to the Office action

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to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a representative illustration or figure of the embodiment “providing” “comments” or “data supplements” wherein the “data supplements” comprise “graphical” or “textual” or “video data” that are “related to” the “media presentation” and presented in a “split-picture presentation” or “picture-in-picture presentation” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

8. Claims 43 and 55 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the specification discloses that a discount may be provided in conjunction with agreeing to watch advertisements, however, there is no suggestion in the originally filled specification that this discount results in the media presentation being free as claimed.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-4, 11-14, 18-21, 32-35, 40, 44-45, 47, and 52 are rejected under 35

U.S.C. 102(e) as being anticipated by Dodson et al. (US Pat No. 6,184,877).

In consideration of claim 1, the Dodson et al. reference discloses a method whereby an “interactive media services client” [102] is coupled to an inherent “programmable media services server device” associated with a cable provider headend in order to provide television program information. The method involves “providing the user with a media presentation” or broadcast program. During the presentation, the client [102] may “receive user input” [100] requesting for “on-screen comments” [400/500] to be provided alongside the “media presentation”(Col 2, Line 59 – Col 3, Line 56). This information is subsequently provided as illustrated in Figures 2-5.

Assuming arguendo regarding the inherent “programmable media services server device”, the claim is not limiting with respect to the composition or nature of services provided by the “programmable media services server device”. Accordingly, the claimed limitations for this “device” may alternatively be met such that the reference suggests that the cable operator comprises a database or “programmable media services server device”

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database that may be accessed via the Internet [106] in order to provide program information (Col 3, Lines 11-16).

Claim 2 is rejected wherein the “comments” include “director comments” and “viewer comments” comprising a review of the presentation (Col 3, Lines 50-56).

Claim 3 is rejected wherein the process for “receiving user input” as disclosed by Dodson et al. is a multi-step process. Accordingly, the claimed limitations may be met such that “prior to the step of receiving said user input” to request the display of particular “on-screen comments” [400/500], the user is “prompted” for “input” pertaining to the particular search terms to utilize for the search (Col 3, Lines 28-40).

Claim 4 is rejected wherein the media presentation may be a “movie” (Figure 5).

Claims 11 and 18 are rejected as aforementioned in the rejection of claim 1 wherein the “client device” comprises “means” or a “processor” [108] coupled/connected to “memory” [110] that is configured to “provide a user with a media presentation” or television program and “comments related to the media presentation” [400/500] in response to “user input” [100].

Claims 12 and 19 are rejected wherein the “comments” [400/500] are “not an inherent part of the media presentation” in that they may be received from an external source such as the Internet [106] (Col 5, Lines 24-26).

Claims 13 and 20 are rejected wherein the “comments” include “director comments” and “viewer comments” comprising a review of the presentation (Col 3, Lines 50-56).

Claims 14 and 21 are rejected wherein the user may “determine the type of comments” based on user input [104] (Figure 4).

Claim 32 is rejected in view of claim 1 wherein the “on-screen comments” are a form of “data supplements”. As aforementioned, the method involves “providing the user with a media presentation” or broadcast program. During the presentation, the client [102] may “receive user input” [100] requesting for “on-screen comments” [400/500] to be provided alongside the “media presentation”(Col 2, Line 59 – Col 3, Line 56). This information is subsequently provided as illustrated in Figures 2-5.

Claim 44 is rejected in view of claim 1 wherein the embodiment comprises inherent “media presentation logic” and “data supplementation logic” [108] that causes the “client device” [102] to provide the user with “data supplements related to said media presentation” in response to “user input requesting said data supplements” [104].

Claims 33 and 45 are rejected wherein the client device is a “television set-top-box” [102].

Claims 35 and 47 are rejected wherein as illustrated in Figure 5 the “supplemental data” comprises “textual data”.

Claims 40 and 52 are rejected wherein the “data supplements” are “synchronized with said media presentation” in so far as they relate to the current televised program (Col 3, Lines 30-32).

11. Claims 32-36, 39, 41-48, 51, and 53-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Neel et al. (US Pat No. 5,838,314).

Claim 32 is rejected wherein the Need et al. reference discloses an “interactive media services client device” [1030] (Col 23, Lines 33-53) coupled [1036] (Col 23, Lines 10-32) to a “programmable media services server” [1002] (Col 20, Line 40 – Col 21, Line 30). The



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method involves “receiving user input” [1038] requesting that “data supplements” or advertisements be provided (Figure 4). The embodiment subsequently “provides the user with a media presentation” associated with VOD movies and “data supplements related to the media presentation” in the form of advertisements (Col 13, Lines 29-33).

Claim 44 is rejected in view of claim 32 wherein the embodiment comprises inherent “media presentation logic” and “data supplementation logic” [1004] (Col 20, Lines 61-64) that causes the “client device” [1030] to provide the user with “data supplements related to said media presentation” in response to “user input requesting said data supplements” [1038] (Col 6, Lines 7-25).

Claims 33 and 45 are rejected wherein the “client device” [1030] is a “television set-top box” (Col 23, Lines 33-53).

Claims 34-36, 39, 46-48, and 51 are rejected wherein the “data supplements” comprise “graphical data”, “textual data”, “video data”, and “audio data” (Col 15, Lines 2-55).

Claims 41 and 53 are rejected wherein the “data supplements” comprise “advertising” (Col 6, Lines 7-25).

Claims 42-43 and 54-55 are rejected wherein the user is “provided with a discount” in the form of a being able to view the “media presentation for free” in “consideration for said user agreeing to be provided with said advertising” (Col 6, Lines 7-25).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 5-8, 15-17, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodson et al. (US Pat No. 6,184,877).

In consideration of claim 5, the reference does not explicitly disclose nor preclude that the "movie" transmitted by the cable provider is a "video-on-demand movie". The reference is not limiting with respect to the particular nature of the programming. It would have been obvious to one having ordinary skill in art at the time of the invention was made that the television program disclosed in the Dodson et al. reference may be that associated with a "video-on-demand movie" since it was known in the art that "video-on-demand movies" is simply a particular distribution technique/method for the cable operators with which to distribute "movies".

Claim 6 is rejected wherein the user may "determine the type of comments by selecting an option displayed on a display device" (Figure 4).

Claim 7 is rejected wherein the “user selects the displayed option”, as shown in Figure 4, by “activating a button” [208] on a “remote control device [104].

Claim 8 is rejected wherein the “display device” is a “television screen” [100].

Claims 15 and 22 are rejected as aforementioned in the rejection of claim 5 wherein it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the Dodson et al. embodiment, if necessary, such that the disclosed received “movie” may be a “video-on-demand movie”.

Claims 16 and 23 are rejected wherein Figure 4 illustrates the limitation wherein the “user selects the displayed option” by “activating a button” [208] on a “remote control device [104].

Claims 17 and 24 are rejected wherein the “display device” is a “television screen” [100].

15. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodson et al. (US Pat No. 6,184,877), in view of Shah-Nazaroff et al. (US Pat No. 6,317,881).

In consideration of claims 9-10, the Dodson et al. embodiment is operable to “receive comments from the user related to the media presentation” and to subsequently “provide at least a portion of said comments to another user”. As illustrated in Figure 5, the embodiment provides the user with the ability to read movie reviews that have been written subsequently to a user having been “presented” with the “media presentation”.

Assuming arguendo, the Shah-Nazaroff et al. reference explicitly discloses method for “receiving comments from the user related to the media presentation” and for further “providing at least a portion of said comments to another user” (Figure 2; Col 7, Lines 9-18). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of

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the invention to modify the Dodson et al. embodiment, if necessary, with the teachings of Shah-Nazaroff et al. for the purpose of providing an improved method and apparatus to collect and provide viewer feedback in order to help viewers find programs of interest (Shah-Nazaroff et al.: Col 1, Lines 31-60).

16. Claims 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (US Pat No. 6,263,501) in view of Dodson et al. (US Pat No. 6,184,877).

Claim 25 is rejected as aforementioned in the rejection of claim 1 wherein the set-top box [102] of Dodson et al. may be broadly construed as a “programmable media services server” that presents media to the user via a “client device” such as a television display [100].

Assuming arguendo, the Dodson et al. reference does not provide details pertaining to the composition of a cable operator based “programmable media services server”. The Schein et al. reference discloses a “programmable media services server device” [310] for presenting media to a user via an “interactive media services client device” [320]. The “server device” comprises a “memory” [314] and a “processor” [312] that is coupled to the “memory” [314] that is “configured to provide a user with a media presentation” as well as other information relating to the media presentation” through linked services in response to “user input” (Col 12, Lines 49-67; Col 14, Lines 36-55; Col 16, Line 46 – Col 17, Line 5; Col 19, Lines 30-36). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Dodson et al., if necessary, to include a “programmable media services server” [310] as illustrated in Schein et al. for the purpose of providing an alternative means for retrieving “comments” that does not need to tie up the phone lines (Schein et al.: Col 16, Lines 46-53) and to further provide a means for allowing the viewer to

retrieve, search, select, and interact with information located in a remote database through a variety of variety of interfaces and further facilitates the purchasing of related goods (Schein et al.: Col 2, Line 20 – Col 3, Line 20).

Claim 26 is rejected wherein the “comments” [400/500] of Dodson et al. are “not an inherent part of the media presentation” in that they may be provided optionally and are derived/received from an external source such as the Internet [106] (Col 5, Lines 24-26).

Claim 27 is rejected wherein the “comments” include “director comments” and “viewer comments” comprising a review of the presentation (Dodson et al.: Col 3, Lines 50-56).

Claim 28 is rejected wherein the Dodson et al. reference suggests that the user may “determine the type of comments” based on user input [104] (Figure 4).

Claim 29 is rejected wherein the Schein et al. reference suggests that the “media presentation” may be a “video-on-demand movie” (Schein et al.: Col 22, Lines 45-46).

Claim 30 is rejected wherein the “user selects the displayed option” as illustrated in Figure 4 of Dodson et al. by “activating a button” [208] on a “remote control device [104].

Claim 31 is rejected wherein the “display device” of Dodson et al. is a “television screen” [100].

17. Claims 37-38 and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodson et al. (US Pat No. 6,184,877).

In consideration of claims 37-38 and 49-50, the Neel et al. reference discloses that the advertisements may be presented during the media presentation (Col 14, Lines 64-67). The reference, however, does not explicitly disclose nor preclude the particular presentation techniques utilized in displaying the “data supplements” during the media presentation. The

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examiner takes OFFICIAL NOTICE that the use of split-picture presentation and picture-in-picture presentation of information is notoriously well known in the art. It would have been an obvious matter of design choice to display the video data supplements in a "split-picture", or "picture-in-picture" display manner, since application has not disclosed that the particular presentation method solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any "data supplement" display format methods known in the art including the use of full screen presentations, "split-pictures", or "picture-in-picture" displays.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Goldschmidt Iki et al. (US Pat No. 6,601,103) reference discloses a method and apparatus for providing personalized supplemental programming.
- The Blahut et al. (US Pat No. 5,532,735) reference discloses a technique for an interactive television system wherein viewers are allowed to select a desired level of advertisements with which they are provided in return for reduced fees.
- The DeLang (US Pat No. 6,020,912) reference discloses a video-on-demand system comprising a server station and a user station that is adapted to charge reduced fees based upon the viewing of commercials.

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- The Reimer et al. (US Pat No. 5,696,905) reference discloses a system and method for providing on demand access to information related to a movie while the movie is being presented to a user.
- The Adams (US Pat No. 6,378,130) reference discloses an improved media server interconnect to a subscriber terminal for a video-on-demand architecture.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907.

The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

SEB  
September 14, 2003

  
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